

### Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The Office Action dated November 14, 2002, indicated that claims 2, 4, 6, 15 and 17 stand rejected under §112(2) as being indefinite; and claims 1-16 and 18-24 stand rejected under §103(a) as being unpatentable over *Bruce et al.* (U.S. Patent No. 6,146,014) in view of Channin (U.S. Patent No. 3,934,199).

With respect to the request for application serial number 09/520,597 Applicant has enclosed a copy of the application.

Applicant respectfully traverses the §112(2) rejections of claims 2, 4 and 6 as the claims are not indefinite. Regarding claim 2, the phrase "near a failure condition" refers to a circuit's operating parameters. Each circuit is manufactured to perform within specified operating parameters such as speed or temperature. To operate at a near failure condition is to operate the circuit at parameters exceeding the known limits thereby stressing the circuit. A specific example may be found at page 7, lines 3-16 of the instant specification. Further, the rejection is improper since the instant application does not claim detecting "near a failure condition." Subject matter that is not claimed is not subject to §112 disclosure requirements as supported by current case law. *Zygo Corp. v. Wyko Corp.*, 79 F.3d 1563, 1567 (Fed. Cir. 1996) ("the parameters of a section 112 inquiry are set by the claims" and such "[u]nclaimed subject matter is not subject to the disclosure requirements of §112.") (emphasis in original). In view of the above discussion and since detection of near a failure condition is not claimed, Applicant submits that the §112 rejection is improper and should be withdrawn.

Regarding the rejection of claim 4, Applicant submits that the above discussion with respect to operating a circuit near a failure condition should overcome the rejection.

Regarding claim 6, radiation from the nIR light is absorbed via free carrier or phonon absorption by the die. *See*, Specification, page 7, lines 7-10.

Regarding the rejection of claim 15, Applicant has amended the claim to remove the phrase "averaging the images."

Claim 17 has also been amended in accordance with the Examiner's suggestion to remove the word "possible" and further clarify that heat transfer occurs.

Applicant respectfully traverses the §103(a) rejections because the cited '014 reference is not prior art pursuant to 35 U.S.C. §103(c). As set forth in M.P.E.P. §706.02(l)(1), effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. §103 via 35 U.S.C. §102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." The '014 reference is, and has been over the entire relevant time period when the instant invention was made, owned by the same entity, Advanced Micro Devices ("AMD"), or subject to an obligation of assignment to the same entity assigned to the same assignee of the instant application. These common assignments are evidenced by the cover sheet of the '014 reference, and by the instant assignment recorded at reel/frame number 012046/0664.

Applicant also submits that a *prima facie* case of obviousness has not been presented, as the Office Action fails to present evidence of motivation in support of the proposed modification of the '014 reference. Evidence has not been provided of any teaching or suggestion for using the '014 reference in connection with a liquid crystal layer, as claimed in the instant invention, or for modifying the reference to achieve the claimed limitations. Recent case law indicates that evidence of motivation must be specifically identified and shown by some objective teaching in the prior art leading to the modification. "Our court has provided [that the] motivation to combine may be found explicitly or implicitly: 1) in the *prior art references* themselves; 2) in the knowledge of those of ordinary skill in the art that certain *references*, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, 'leading inventors to look to *references* relating to possible solutions to that problem.'" Ruiz v. A.B. Chance Co., 234 F.3d 654, 57 U.S.P.Q.2d 1161 (Fed. Cir. 2000). The Office Action fails to identify evidence of why one skilled in the art would be led to modify the '014 reference, and does not provide any evidence of factual teachings,

suggestions or incentives from the prior art that lead to the proposed modification.

Applicant requests that the rejections be withdrawn.

Moreover, the §103(a) rejection is improper as the proposed modification would undermine the purpose of the '014 reference. The '014 reference is directed to analyzing temperature characteristics by measuring the intensity level of laser light reflected from an integrated circuit and comparing the intensity level to a reference intensity level. The Office Action proposes applying a liquid crystal layer onto the surface of the '014 die which would likely degrade the laser light reflected from the circuit thereby skewing the intensity measurements. The liquid crystal layer would hinder accurately measuring the reflected light's intensity ruining any effective comparison to the reference. To allege under §103 that a skilled artisan would modify the '014 reference in such a manner is untenable and impermissible under §103. *See, e.g., In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) (A §103 rejection cannot be maintained when the asserted modification undermines the purpose of the main reference.)

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

CRAWFORD MAUNU PLLC  
1270 Northland Drive, Suite 390  
St. Paul, MN 55120  
651/686-6633

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By: 

Robert J. Crawford  
Reg. No. 32,122

Enclosed: Copy of patent application serial number 09/520,597

**Claim Changes for S/N 09/915,883**

15. (Amended) The method of claim 14, wherein using the nIR laser light to image the liquid crystal includes [taking] evaluating a plurality of images of the liquid crystal [and averaging the images].

17. (Amended) The method of claim 1, further comprising removing [an] sufficient amount of substrate from the die [that makes possible] for heat transfer from the circuitry to the liquid crystal in a manner that causes a portion of the liquid crystal to reach a temperature near its threshold temperature for changing phase, wherein the liquid crystal is formed over the die after the substrate removal.